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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/696,609 | 10/24/2000 | Klaus Hofrichter | SONY-50N3765 | 3968 |

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| EXAMINER |
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SALCE, JASON P

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| ART UNIT | PAPER NUMBER |
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2623

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/696,609 | Applicant(s) HOFRICHTER ET AL. | |
| | Examiner Jason P. Salce | Art Unit 2623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/17/2006 have been fully considered but they are not persuasive.

Applicant argues that, "Indeed, Sezan's description scheme generation module and program analysis module provide data to a data storage unit. It is well known that data is not properly equivalent to executable instructions. Thus, Sezan does not teach or suggest that the system description schedule includes "executable storage management instructions" that cause automated management of the media storage device, as claimed". The examiner disagrees and notes Column 7, Lines 18-24, which states that the stored data can be executed to determine what programs to record, therefore Sezan clearly teaches machine executable code, which when executed, directs the system to record television programs. In other words, the data must be executed by the system's processor in order for the system to know what programs to record.

Applicant also argues that Kunkel does not teach machine executable instructions. See arguments above for Sezan teaching this limitation.

Applicant also argues Kenner does not teach or suggest updating the stored program with the updated version of the particular one of the plurality of clips, as recited in claim 32 because Kenner only discloses updating a locally stored video clip. The examiner notes that nowhere in the claim is remote storage of a video clip required.

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However, even if remote storage is required, see Column 4, Lines 43-45 for both local and remote storage of the video clips.

Applicant also argues that the examiner has not demonstrated the motivation required to combine Sezan and Kenner, because the motivation has not been taken from the reference. Although the MPEP does not require motivation to be specifically taught by the reference, see Column 3, Lines 60-64 for Kenner teaching that, "the invention provides a true or complete distributed architecture with increased reliability and the capability of supporting thousands of simultaneously attached user, at a fraction of the cost of the massively parallel system".

Therefore, in view of the Applicant's arguments failing to be persuasive the rejection stands and is provided below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 4, 6 – 9, 11 – 14, 16 – 19, 21 – 24, 26 – 29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Sezan et al (6,236,395).

Regarding claim 1, Sezan discloses a method and a computer readable medium for enabling an electronic device for automated management of a on-site storage device (see col 6 lines 23 – 39 and col 7 lines 7 – 40). Sezan discloses receiving and radio and video programs and recoding the programs (see col 7 lines 7 – 38, col 6 lines 23 – 39). Sezan further discloses receiving context data describing the received programs (see description scheme – col 5 lines 33 – 46, col 6 lines 1 – 38 and col 9 lines 13 – 48). In addition, Sezan discloses, “*The system description scheme 22 preferably **manages the individual programs and other data***” (see col. 6 lines 23 – 25). Sezan further discloses “*...the system description scheme will be capable of **storing the information contained within the program description scheme, so that information is properly indexed. With proper indexing, the system is capable of matching such information with user information, if available, for obtaining and recording suitable programs***” (see col. 7 lines 18 – 24). Thus Sezan discloses an executable system description scheme which is used for storing and managing programs and other data i.e. content data and context data. It is noted that the managing and indexing is done without requiring user input. Sezan also discloses “*The system, in an **autonomous manner, periodically obtains and records the audiovisual information that may be of interest to the user...***” (see col. 9 lines 48 – 52) and thus discloses storing without requiring user input.

Regarding claim 2, Sezan inherently discloses the claimed processor and computer readable memory as required to perform the function of automated

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management of data stored on the storage medium (see col 6 lines 23 – 39, col 6 line 63 – col 7 line 40).

Regarding claims 3, 13 and 23, Sezan discloses *“It is preferred to maintain the program description scheme separate from the **system description scheme** because the **content providers repackage the content and description schemes** in different styles, times and formats”* (see col. 7 lines 40 – 45) and thus discloses a storage management service provider located remotely from said media storage device.

Regarding claim 4, Sezan discloses the claimed managing content data and context data of media signal stored on the media storage device according to storage management instructions (see col 9 lines 1- 7, col 9 line 40 – col 10 line 37, col 7 lines 7 – 38).

Regarding claims 6 and 8, Sezan discloses deleting of stored programs and writing of programs (see col 11 lines 50 – 67) per a user description profile scheme and the system description scheme. It is noted that the system description scheme is used for the recording or writing of new media signal (see col. 7 lines 16 – 49) thus Sezan discloses the claimed “allowing overwriting of a new media signal over a media signal recorded onto said media storage device in accordance with said storage management instructions”.

Regarding claim 7, Sezan discloses receiving user preferences from said on-site user (see col 5 lines 37-45, col 9 lines 40 – 50).

Regarding claims 9 and 31, Sezan discloses *“the system description scheme may be transported to the source to provide the source with view or other capabilities*

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that the device with image, audio and/or video content customized or otherwise suitable for the particular device" (see col. 8 lines 1 – 8) and also discloses "...because the content providers repackaging the content and description schemes in different styles, times and formats" and thus discloses the claimed limitations.

updating the description schemes (see col 6 lines 1 – 6, col 9 lines 9 – 25).

Claims 11 and 21, are met by the discussions above.

Regarding claims 12 and 22, Sezan discloses enabling the storage management instructions to execute on the on-site media storage device (see col 6 lines 23 – 39, col 6 line 63 – col 7 line 40).

Claims 14, 16, 18, 19, 24, 26, 28 and 29 are met by the discussions above.

Regarding claims 17 and 27, Sezan discloses a system description scheme records programs based on preference data in user description scheme (see col. 9 lines 41 – 52, col. 7 lines 7 – 15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5, 10, 15, 20, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sezan et al (6,236,395) in view of Kunkel et al (US 2002/0056093).

Regarding claims 5, 10, 15, 20, 25 and 30, Sezan fails to disclose providing context-sensitive management and wherein the storage management instructions are capable of managing a discrete context-content clip of data.

In analogous art, Kunkel teaches a system which filters additional descriptive information at the set-top box according to demographic information for the benefit of providing more targeted additional information. Therefore, it would have been obvious to an artisan skilled in the art at the time of the invention to include managing the context of description scheme in Sezan for the benefit of targeting and thus providing descriptive information that a user would find more interesting or useful.

4. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sezan et al (6,236,395) in view of Kenner et al (US 5,956,716).

Regarding claims 32 and 33, as discussed above, Sezan discloses receiving executable storage management instructions at a media storage device to record a program by receiving context data associated with the program, wherein the storage management instructions instruct the media storage device to store the program and automatically executing the received storage management instructions without requiring a user input. Sezan fails to disclose receiving an updated version of a particular one of a plurality of clips of a program stored at a media storage device and using the management instructions to store one of the plurality of clips.

Kenner teaches storing video clips at a user device. Kenner further recognizes the video clips stored may not be current and thus teaches providing updated clips to a user device (see col. 5 lines 1 – 15, col. 28 lines 59 – 65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sezan to include the claimed limitations for the benefit of providing a user with the most up-to-date and recent clips and programming.

Regarding claim 33, the combination of Sezan and Kenner teaches the claimed limitation. It is noted that since Kenner teaches receiving a displaying a updated clip, necessarily the user can output a program before the updated clip is received or can also output the program after the updated clip is received.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce
Primary Examiner
Art Unit 2623

August 11, 2006

A handwritten signature in black ink, appearing to read 'Jason Salce', written in a cursive style.